

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Petra Cirpus et al.

Application No.: 10/590,457

Confirmation No.: 8604

Filed: August 25, 2006

Art Unit: N/A

For: **METHOD FOR PRODUCING
POLYUNSATURATED FATTY ACIDS IN
TRANSGENIC PLANTS**

Examiner: Not Yet Assigned

RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE

MS PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Notification of Defective Response dated March 9, 2009. A copy of the Notification is enclosed herewith.

Applicants note that the fee of \$130 for English translation surcharge listed at page 1 of the Notification is not required as per the Decision on Petition under 37 C.F.R. § 1.181 dated February 3, 2009. A copy thereof is also enclosed herewith.

Applicants further note that replacement copies of the Sequence Listing that conform to 37 CFR §§ 1.821-1.825 and the Sequence Listing in computer readable form, all on compact disc, have been submitted to the Office on May 17, 2007 in response to the Notification of Missing Requirements Under 37 U.S.C. § 371 in the United States Designated/Elected Office (DO/EO/US) dated April 2, 2007. Accordingly, no new substitute Sequence Listing is required in response to the present Notification.

As stated at page 2 of the present Notification, additional application size fee of \$1,250.00 for 229 pages in excess of 250 pages is required to complete the response to the Notification of Missing Requirements Under 37 U.S.C. § 371 in the United States Designated/Elected Office (DO/EO/US) dated April 2, 2007. Accordingly, Applicants submit

herewith the payment of \$1250 as required to complete the response to the Notification of Missing Requirements filed on May 17, 2007.

Accompanying this submission is the authorization to charge the amount of \$1,250.00 covering the required fees. No further fee is believed due. However, if any additional fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 13987-00020-US from which the undersigned is authorized to draw.

Respectfully submitted,

By /s/ Hui-Ju Wu

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/590,457	Petra Cirpus	13987-00020-US
23416	INTERNATIONAL APPLICATION NO.	
CONNOLLY BOVE LODGE & HUTZ, LLP	PCT/EP05/01863	
P O BOX 2207	I.A. FILING DATE	PRIORITY DATE
WILMINGTON, DE 19899	02/23/2005	02/27/2004

CONFIRMATION NO. 8604
371 FORMALITIES LETTER



OC000000034875010

Date Mailed: 03/09/2009

NOTIFICATION OF DEFECTIVE RESPONSE

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated Office (37 CFR 1.494):

- Priority Document
- Copy of the International Application filed on 08/25/2006
- English Translation of the IA filed on 08/25/2006
- Copy of the International Search Report filed on 08/25/2006
- Information Disclosure Statements filed on 08/25/2006
- Biochemical Sequence Diskette filed on 08/25/2006
- Oath or Declaration filed on 08/25/2006
- Biochemical Sequence Listing filed on 08/25/2006
- Request for Immediate Examination filed on 08/25/2006
- U.S. Basic National Fees filed on 08/25/2006
- Specification filed on 08/25/2006
- Claims filed on 08/25/2006
- Abstracts filed on 08/25/2006

Applicant's response filed 08/25/2006 is hereby acknowledged. The following requirements set forth in the NOTIFICATION of MISSING REQUIREMENTS mailed 04/02/2007 have not been completed.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Processing fee of \$130 for providing the translation of the application and/or the Annexes later than 30 months from the priority date (37 CFR 1.492(i)).

SUMMARY OF FEES DUE:

Total additional fees required for this application is \$1380 for a Large Entity:

- \$130 for English translation surcharge required.
- A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached copy of the marked-up "Raw Sequence Listing." Applicant must provide a substitute computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). Refer to attachment or PAIR document dated .

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).

- The fee for submitting a specification and drawing containing more than 100 pages has not been paid in full. Applicant owes **\$1250** for **229** pages in excess of **250** pages for a large entity.

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:

- **For Rules Interpretation, call (571) 272-0951**
- **For Patentin Software Program Help, call Patent EBC at 1-866-217-9197 or directly at 703-305-3028 / 703-308-6845 between the hours of 6 a.m. and 12 midnight, Monday through Friday, EST.**
- **Send e-mail correspondence for Patentin Software Program Help @ ebc@uspto.gov**

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.
<https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at **1-866-217-9197** or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

INDIA L EVANS

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In re Application of
CIRPUS, et al.
Serial No.: 10/590,457
PCT No.: PCT/EP05/01863 : DECISION ON PETITION
Int. Filing Date: 23 February 2005 :
Priority Date: 27 February 2004 : UNDER 37 CFR 1.181
Atty Docket No.: 13987-00020-US :
For: METHOD FOR PRODUCING POLY-
UNSATURATED FATTY ACIDS IN TRANS-
GENIC PLANTS :
:

This decision is in response to applicant's correspondence and filed 21 May 2007 in the United States Patent and Trademark Office (USPTO). The request is being treated under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 08 September 2006, applicant filed the present request for refund arguing that a preliminary amendment had been filed with the U.S. National stage entry eliminating all multiple dependencies.

DISCUSSION

On 23 February 2005, applicant filed international application PCT/EP05/01863, which claimed priority of an earlier application filed 27 February 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 September 2005. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 August 2006.

On 25 August 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an executed declaration and power of attorney; an English translation of the international application as filed; a preliminary amendment; a computer - readable form of the sequence listing and an Application Data Sheet.

On 14 March 2007, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an translation of the application into English and processing fee of \$130.00. In addition, applicant was advised of the need to provide a payment of \$1250.00 for 229 pages in

excess of 250 pages. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 02 April 2007, applicant was mailed an additional Form PCT/DO/EO/905 advising applicant of the need to provide payment of a processing fee of \$130.00 for providing an English translation of the international application later than 30 months from the priority date and to provide a payment of \$1250.00 for 229 pages in excess of 250 pages. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees. The form was accompanied by a withdrawal of the Form PCT/DO/EO/905 mailed 14 March 2007.

On 21 May 2007, applicant filed the present petition under 37 CFR 1.181 arguing that an English translation of the international application as filed was timely provided on 25 August 2006 and therefore payment of the \$130.00 surcharge was not necessary. In addition, applicant argued that applicant had filed a preliminary amendment on 25 August 2006 requesting the deletion of the paper copy of the Sequence Listing from the international application and replacement with Sequence Listing submitted on compact disc only.

DISCUSSION

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. (See MPEP 503). An examination of the petition finds that applicant has provided a copy of the date-stamped postcard receipt, as well as, a complete copy of the prior filing and a statement that the copy currently provided is a copy of the papers filed on 25 August 2006. The postcard identifies the application by serial number, title, applicant and attorney docket number. Among the items listed on the receipt is: "English language translation of the International Application" The receipt is stamped "IAP15 Rec'd PCT/PTO 25 AUG 2007." The postcard has not been annotated in any way to indicate that any of the listed items were not received. Thus, it is clear that applicant filed an English translation of the international application on 25 August 2006; within thirty months from the earliest claimed priority date. Thus, it is proper to grant applicant's petition to not have to pay the \$130.00 surcharge for untimely filing of an English translation of the international application.

Regarding the charging of \$1250.00 for 229 pages in excess of 250 pages, applicant is advised that the filing date of this application is the international filing date. The international application contained a paper copy of the sequence listing and was published with said paper version. Applicant is advised that an applicant is not allowed to amend the specification after the filing date. As such, applicant's preliminary amendment of 25 August 2006 to delete the paper copy of the Sequence Listing from the international application and replacement with Sequence Listing submitted on compact disc only is untimely. (See Manual of Patent Examining Procedure section 714.01(e)). In addition, it is noted that MPEP 1.825(a) provides that:

Any amendment to a paper copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of substitute sheets and include a statement that the substitute sheets include no new matter. Any amendment to a compact disc copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of a replacement compact disc (2 copies) in compliance with § 1.52(e). Amendments must also be accompanied by a statement that indicates support for the amendment in the application, as filed, and a statement that the replacement compact disc includes no new matter.

As such, there is no provision for amending a paper copy of a sequence listing filed in the international application with a computer readable version upon the entry of the National stage in the United States.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **DISMISSED** as to the need to provide payment of \$1250.00 for 229 pages in excess of 250 pages. The petition is **GRANTED** as to the timeliness of the filing of the English translation of the international application.

This application is being returned to the United States Designated/Elected Office (US/DO/EO) for the preparation and mailing of a "Notification of Defective Response" (Form PCT/DO/EO/916) indicating that applicant is required to provide payment of \$1250.00 for 229 pages in excess of 250 pages.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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